

I. OBJECTION TO SPECIFICATION

At page 2 of the Office action, the Examiner has objected to the specification alleging that the use of the terms “analog” and “agonist” are used interchangeably. The Examiner advises Applicant to “remain consistent” and “adopt one terminology” throughout the specification.

Applicants respectfully submit that their use of the terms “analog” and “agonist” are not inconsistent, and would not cause confusion to one of skill in the art. The term “analog” is used to describe the structure of the compound; for example, when used to describe a compound as a “GnRH analog,” the term means that the compound has a structure analogous to GnRH. The term “agonist” is used to refer to the compound's activity. Thus, referring to a particular compound as a “GnRH agonist” merely indicates that the compound has agonistic activities toward GnRH (i.e., it is capable of coupling with a GnRH receptor and initiating a response similar to that obtained from GnRH). In short, the two terms are not mutually exclusive, but refer to different aspects of the compound: its structure and its activity. Applicants use “analog” when they wish to emphasize the compound's structure, and use “agonist” when they wish to emphasize the compound's activity. Thus, the use of the two terms is consistent with their accepted meanings, and would be readily understandable to one of skill in the art. Applicants submit that the Examiner's objection should be withdrawn.

II. INDEFINITENESS REJECTION

At pages 2-3 of the Office action, the Examiner has rejected claims 1-17 because they use the terms “analog” or “agonist,” which the Examiner regards as

indefinite. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

Applicants have explained above the meanings of these terms, and explained why one of skill in the art would understand their meanings. Nothing about their recitation in the alternative in the claims would create any ambiguity. If a compound has a structure that is an analog to GnRH, it is included within the scope of the claim. If the compound has an activity that is agonistic to GnRH, then it is included within the scope of the claim. Because the scope of the claim is clearly defined, there is no ambiguity giving rise to a rejection under 35 U.S.C. § 112, second paragraph, and the Examiner's rejection should be withdrawn.

The Examiner indicates that confusion arises because "an analog could also be an antagonist and one of skill in the art probably would not use an agonist and an antagonist together." However, as the Examiner is doubtless well aware, the specification is not to be read in a vacuum, but rather is addressed to those of skill in the art. *In re Howarth*, 201 USPQ 689 (CCPA 1981). If such a person would recognize that a composition containing an antagonist/analog and an agonist would have no utility when used together, then they would not combine the compounds, and the claim would not read thereon. It is not the function of the claims to exclude every conceivable inoperative embodiment, particularly where, as the Examiner has indicated, one of skill in the art would readily be able to determine whether any particular embodiment might be inoperative. *In re Cook*, 169 USPQ 298 (CCPA 1971).

The Examiner also indicates that claims 11 and 12 are duplicates of claim 1. However, these claims recite that the composition is to be used to induce ovulation in female mammals. The concentration of GnRH, GnRH agonist, and/or GnRH analog sufficient to induce ovulation in female mammals may be different from that needed to induce ovulation in non-mammals, and may be different from the composition as synthesized, sold, etc. As a result, specifying that the composition is suitable for use in inducing ovulation in a particular type of animal further limits the scope of claim 1, and the claims are not duplicative.

III. SAME INVENTION DOUBLE PATENTING

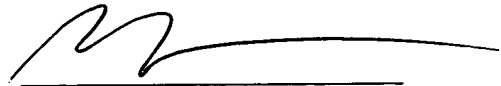
At page 5 of the Office action, the Examiner has rejected claims 1-6 and 8-10 as claiming the same invention as that of claims 1-6 and 8-10 of U.S. Patent No. 6,051,558. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

The Examiner states that “the recitation of method of use in the mentioned claims has not been given any patentable weight because the recitation occurs in the preamble.” Applicants respectfully submit that it is inappropriate to ignore the preamble in the manner suggested by the Examiner. Nevertheless, the Examiner’s rejection is inappropriate for another reason. Claim 1 of the present application explicitly recites GnRH agonists. Claim 1 of the ‘558 patent does not contain this explicit recitation. Accordingly, it is possible to infringe one claim without infringing the other, irrespective of whether one ignores the claim preamble. As a result, the Examiner’s rejection fails the test set forth in *Vogel*, and should be withdrawn.

Applicants respectfully submit that the claims are in condition for immediate allowance.

Please charge any fees in connection with this filing to Deposit Account No. 11-0855.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Bruce D. Gray', written over a horizontal line.

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